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43. (Newly added) The method of Claim 41, which is operated through a data network.

44. (Newly added) The method of Claim 41, wherein the data network is the internet.

REMARKS

This Response is submitted in response to the Office Action dated July 11, 2002. Claims 1, 2, 6, 7, 11, 12, 13, 14 and 15 have been amended, Claims 9 and 10 have been cancelled without prejudice or disclaimer. New Claims 16 to 44 have been added. No new matter has been added.

The Examiner objected to the Abstract of the Disclosure as not in the proper Abstract language and format. Applicant has amended the Abstract to contain less than 150 words, and to overcome the Examiner's language and format objections.

The Examiner also objected to the title of the invention as not descriptive, and suggested the following title: "Slot Machine with Hyperlinked Paytable Information." Applicant respectfully disagrees with the Examiner's objection. The claimed invention is only limited by the scope of the claims, and is not limited to slot machines with hyperlinked payable information. Accordingly, applicant has not amended the title.

The Examiner also objected to Claims 7, 9, and 10 under 37 C.F.R. 1.75(c) as being in improper dependent form for failing to further limit the subject matter of a previous claim. Claim 7 has been amended to overcome this rejection and not for the purpose of distinguishing over the prior art. Claims 9 and 10 have been cancelled without prejudice or disclaimer. The Examiner further objected to Claims 13 to 15 because the language in these claims did not match language of Claim 11 from which they depend. Claims 13 to 15, as well as Claim 12, have been amended to match Claim 11 to overcome this rejection and not for the purposes of distinguishing over the prior art. Similarly, Claims 1, 2 and 11 have been amended for clarity and not for the

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purpose of distinguishing over the prior art. Specifically, Claim 1 has been amended to clarify that the controller causes the display device to display the payable, Claim 2 has been amended to clarify that the reels are controlled by the controller and Claim 11 has been amended to clarify that the reels are controlled by the controller and that the payable associated with the selected symbol is displayed when the player selects that symbol.

The Examiner rejected Claims 6, 7, 9, and 10 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner indicated no antecedent basis for "said displays" exists in claims 6 and 9. Claims 9 and 10 have been cancelled. Claims 6 and 7 have been amended to overcome this rejection and not for the purposes of distinguishing over the prior art.

The Examiner also rejected Claim 14 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner indicated no antecedent basis existed for "said displays." The Examiner also found the word "togglng" to be inapt. Claim 14 has been amended to overcome this rejection and not for the purposes of distinguishing over the prior art.

The Examiner rejected Claims 1 to 15 under 35 U.S.C. § 103(a) as being unpatentable over Heidel in view of Lemay and Fey. In particular, the Examiner rejected Claims 1, 3, 4, 7, 10, and 11 under 35 U.S.C. § 103(a) as being unpatentable over Heidel et al. in view of Lemay and Fey. Applicant respectfully disagrees with and traverses the Examiner's rejection.

Amended Claim 1 is directed to a gaming device having a controller, a display device connected to the controller, at least one reel displayed by the display device, at least one symbol displayed on the reel, and means connected to the controller for selecting one of the symbols. Claim 1 further includes at least one payable display for said selected symbol stored in said controller, whereby selecting said symbol causes said controller to cause said display device to display a payable display for said selected symbol.

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The Examiner found that Heidel teaches a game controller, a display device attached to the controller, at least one reel displayed on the display device, at least one symbol displayed on the reel, and a touch screen connected to the controller for selecting a symbol. The Examiner further found that Heidel discloses "a payable display for the symbol stored in memory" and that "Heidel teaches displaying the payable when the player pushes the payable area of the screen, not when the player selects a symbol." Contrary to the Examiner's interpretation of Heidel, Heidel expressly states that the display device displays: "a payable 18 that provides the player with the values for various winning combinations of cards." (Col. 2, lines 24-29). Thus, contrary to the Examiner's conclusion, Heidel does not disclose touching a payable area on the screen to display a payable. **[It is however acknowledged that known video slot machines include an area on the display device (including a touch screen) labeled "HELP" or "PAYTABLE" which when touched provide the paytables associated with the video slot game.]**

On the contrary, the present invention is directed to the selection of a symbol on a reel which causes the display of the paytable associated with that selected symbol. The present invention enables the player to easily see the payable associated with a specific selected symbol rather than the paytables associated with all of the symbols. Heidel clearly does not disclose, teach or suggest the selection of a symbol on a reel which causes the display of the payable associated with that selected symbol.

The Examiner relies on Lemay and Fey to supply the elements of Claim 1 missing from Heidel **[or the other known video slot machines]**. With respect to Lemay and Fey, the Examiner explained that: "Fey teaches the traditional appearance of the payable" and that Lemay teaches that "[h]yperlinked, context sensitive help is well known in the art." The Examiner concludes that there is a motivation for combining Lemay and Heidel because the hyperlinks of Lemay make gaining payable information quicker. The Examiner reasons that:

[t]his makes it faster and easier for a user to gain information. The less time spent searching paytables, the more time spent gambling. This leads to greater profits. It would have been obvious to one of ordinary skill in the art at the time of the invention to have displayed payable information about a particular symbol when it was chosen by a player via a hyperlink in order to quickly provide information to the player so that the player

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doesn't have to spend time searching the paytables and can spend more time gambling – thus increasing casino profits.

Contrary to the Examiner's conclusion, the continuously displayed payable of Heidel provides necessarily quicker payable information than combining Heidel with Lemay's hyperlinks to access and display such information. Because Heidel's payable is continuously displayed, combining Heidel and Lemay would add unnecessary steps. Thus, the Examiner's suggested quickness motivation for combining Heidel and Lemay's hyperlinks to display payable information is incorrect. **[Moreover, the addition of a hyperlink to a video slot machine having a payable display simply results in a slot machine providing the currently known features through using hyperlinks. The combination does not suggest providing a new feature wherein the selection of a symbol on a reel, such as the touch of a reel symbol area using a touch screen, causes payable information for that selected symbol to be displayed to the player.]** The Examiner has thus failed to present a *prima facie* case of obviousness because the cited combination of references does not teach or suggest all of the elements of Claim 1.¹

It is also well settled law that obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the claimed invention. ATD Corp v. Lydall, Inc., 48 U.S.P.Q. 2d 1321, 1329 (Fed. Cir. 1998). Virtually all inventions are combinations of old elements (citing Environmental Designs, Ltd. v. Union Oil Co., 218 U.S.P.Q. 865, 870 (Fed. Cir. 1983)). When the Patent Office fails to explain how the skilled artisan would have been motivated by the prior art to make the claimed combination, the court infers that the obviousness determination has been impermissibly made in hindsight. In re Rouffet, supra, (citing In re Gorman, 18 U.S.P.Q. 2d 1885, 1888 (Fed. Cir. 1991)).

¹ A *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03; *In re Fine*, 837 F.2d 1071, 1075-76, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988) (temperature range limitation missing from combined prior art references) *In re Ryoka*, 490 F.2d 981, 180 U.S.P.Q. 2d 580, 583 (C.C.P.A. 1974) (xerography limitation missing after combining references).

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Amended Claim 11 is an independent method claim for providing payable information for a gaming device comprising the steps of displaying at least one symbol on at least one reel connected to a controller of said gaming device, enabling a player to select said symbol, and displaying at least one payable associated with said selected symbol display. Like Claim 1, the Examiner rejected Claim 11 as obvious in view of Heidel, Lemay, and Fey. For the above reasons, the Examiner, therefore, has also failed to establish a *prima facie* case of obviousness of amended independent method claim 11. Claims 2-10, which depend from Claim 1, including amended claims 6 and 7, and amended Claims 12-15, which depend from Claim 11, are also not obvious. *In re Fine*, 837 F.2d at 1076 ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious").

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with Markings to Show Changes Made."

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, applicant respectfully requests that the Examiner contact the applicant's attorney, Adam Masia, at (312) 807-4284 to discuss this Response.

Respectfully submitted,

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Version With Markings to Show Changes Made

In the Specification:

The Title has been amended as follows:

Gaming Device Providing Touch Activated Symbol Paytable Information

The Abstract of the Disclosure has been amended as follows:

The present invention includes an apparatus and method for quickly and easily providing desired payable information to a player of a gaming device. The invention utilizes the game's display device containing a plurality of game generated symbols as an index of symbols from which a player can choose a desired symbol. The present invention enables a player to touch or otherwise select the desired symbol and produce desired payable information, which includes a plurality of different types of information. ~~Touching a desired symbol is simple, interactive and entertaining. Such features are not inherent in the existing methods.~~ The invention contemplates the game maintaining one or more databases for every single symbol. Alternatively, the game can maintain one or more databases having information on all the symbols of the gaming device and immediately scroll to the desired symbol upon the player's selection.

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In the Claims:

Claim 1 has been amended as follows:

1. (Amended) A gaming device comprising:
a controller;
a display device connected to said controller;
at least one reel displayed by said display device;
at least one symbol displayed on said reel;
means connected to the controller for selecting one of said symbols; and
at least one payable display for said selected symbol stored in said controller;

whereby selecting said symbol causes said controller to cause said display device to display a payable display for said selected symbol.

Claim 2 has been amended as follows:

2. (Amended) The gaming device of Claim 1, which includes a plurality of reels ~~controlled by~~ connected to said controller and a plurality of symbols displayed on a plurality of reels.

Claim 6 has been amended as follows:

6. (Amended) The gaming device of Claim 5, wherein said at least one payable display includes a plurality of displays, and wherein each of a said plurality of ~~said~~ displays contains different payable information from each of the other of said plurality of displays.

Claim 7 has been amended as follows:

7. (Amended) The gaming device of Claim 6, which includes means for selecting one of said ~~at least one payable~~ plurality of displays.

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Claim 9 has been cancelled without prejudice or disclaimer.

Claim 10 has been cancelled without prejudice or disclaimer.

Claim 11 has been amended as follows:

11. (Amended) A method of providing payable information for a gaming device comprising the steps of:

- (a) displaying at least one symbol on at least one reel controlled by ~~connected to~~ a controller of said gaming device;
- (b) enabling a player to select said symbol; and
- (c) displaying at least one payable associated with said selected symbol when the player selects said symbol display.

Claim 12 has been amended as follows:

12. (Amended) The method of Claim 11, wherein displaying a at least one payable display includes the step of scrolling through a display to an area displaying said selected symbol.

Claim 13 has been amended as follows:

13. (Amended) The method of Claim 11, wherein displaying a ~~plurality of at least one~~ payable displays includes a plurality of paytables, and the step of sequencing said displays paytables according to a sequence contained in said controller.

Claim 14 has been amended as follows:

14. (Amended) The method of Claim 11, wherein displaying a ~~plurality of at least one~~ payable displays includes a plurality of paytables, and the step of enabling said player to select a means for sequentially ~~scrolling~~ scrolling through said displays paytables.

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Claim 15 has been amended as follows:

15. (Amended) The method of Claim 11, wherein displaying a ~~plurality of~~ at least one payable ~~displays~~ includes the step of enabling said player to select one of a plurality of means for selecting a single ~~display~~ paytable.

Claims 16 to 44 have been added.